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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/485,277	05/17/2000	ACHIM NEUMAYR	1328/3	1728

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RICHARD E JENKINS
JENKINS & WILSON
SUITE 1400 UNIVERSITY TOWER
3100 TOWER BOULEVARD
DURHAM, NC 27707

EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 12/16/2002 //

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-11

Office Action Summary	Application No.		Applicant(s)	
	09/485,277		NEUMAYR ET AL.	
	Examiner		Art Unit	
	Cheryl Juska		1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34, 37-42 and 45-62 is/are rejected.
- 7) ☒ Claim(s) 35, 36, 43 and 44 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>9</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. Amendment B, submitted as Paper No. 10 on September 24, 2002, has been entered. The specification has been amended as requested. Claims 1, 3, 20-22, 24, 37, 38, and 43-53 have been amended, while new claims 54-62 have been added. Thus, the pending claims are 1-62.
2. Said amendment is sufficient to withdraw the 112, 2nd rejections set forth in sections 4 and 6-8 of the last Office Action.

Information Disclosure Statement

3. The information disclosure statement filed May 15, 2002, fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each reference listed that is not in the English language. It has been placed in the application file, but references B2 and B3 referred to therein has not been considered.

Specification

4. The use of the trademark BEROL has been noted in this application. It should be capitalized wherever it appears and ***be accompanied by the generic terminology.***

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Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 13, 43, 44, 60, and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claims 13, 60, and 61 contains the trademark/trade name BEROL. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. (It is noted that in the Remarks section of Amendment B, Applicant asserts claim 13 has been cancelled. However, no formal request has actually been made and the claim remains pending.)

8. Claims 43 and 44 are indefinite because it is unclear if the backing fabric, the pile, or both are comprised of the inventive cellulose fiber.

Claim Rejections - 35 USC § 103

9. Claims 1-16, 18-24, and 26-34 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Joseph reference in view of the cited Beattey and Marini patents, as set forth in section 10 of the last Office Action.
10. Claims 17 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Joseph, Beattey, and Marini references, as applied to claim 1, and in further view of the cited Nishiyama patent, as set forth in section 11 of the last Office Action.
11. Claims 37-42 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Joseph, Beattey, and Marini references, as applied to claims 1 and 33, and as set forth in section 12 of the last Office Action.
12. Claims 45-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Joseph, Beattey, and Marini references, as applied to claim 37 above.

Claims 45-53 were previously rejected under 112 and 101 as improper use claims. However, said claims have been amended to be drawn to specific utility fabrics made in accordance with claim 37. Thus, these claims are now rejected along with claim 37, since said claims merely recite a preamble intended use of the fabric without adding any further structural elements to said fabric.

13. Claims 54-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over the cited Joseph, Beattey, and Marini references.

The limitations of new claims 54 and 55 were previously examined in original claim 3. As such, said claims are rejected for reasons analogous to those presented in the rejection of

claim 3. Similarly, the limitations of new claims 56-62 were previously examined in original claims 20-22 and 24, respectively. Thus, said claims are rejected for analogous reasons.

Response to Arguments

14. Applicant's arguments filed with Amendment B have been fully considered but they are not persuasive.

15. Applicant first argues the Examiner's prior art rejections are based upon impermissible hindsight reasoning. In response, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

16. Applicant also argues that the combination of references fails to teach the wood shoots age, ripening maturity, and twisting of fibers (Amendment B, page 16, 1st paragraph). In response, it is reiterated that the shoot age is a structural limitation in a method claim, and as such is not given patentable weight at this time (see last Office Action, page 5, 2nd paragraph). Additionally, it is reiterated that Marini teaches the claimed ripening maturity, while Beattley teaches the claimed fiber twisting (see last Office Action, page 5 3rd and 4th paragraphs).

17. Applicant also argues that the prior art does not teach a nano-lamellar microstructure or the age of the wood pulp shoots which contributes to such a microstructure (Amendment B, page 17, line 1-page 18, line 5 and page 19, 2nd and 3rd paragraphs). In response, it is noted that the

features upon which Applicant relies (i.e., nano-lamellar microstructure) are not recited in the rejected claims. Only claims 35 and 36 limit the lamellae to a nanometer size. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

18. Additionally, despite Applicant's assertion that "the starting materials do in fact play a role in the production of a cellulose fiber" (Amendment B, page 18, 2nd paragraph), it is reiterated that the age of the wood shoots does effect the method steps in a manipulative sense (i.e., structural limitation in a method claim). The process is the same regardless of the age of the shoots. As such, the prior art rejections based upon the process are maintained.

19. Applicant's arguments are sufficient to establish that the age of the shoots manipulatively effects the final product (i.e., the lamellar microstructure of the cellulose fiber). In other words, the age of the wood shoots is given patentable weight in the product claims. However, the rejections of the fibers and fabrics produced by said process (i.e., claims 33-53) is also maintained at this time due to the language of claim 33, which states a cellulose fiber "obtainable by a process in accordance with claim 1." The "obtainable" claim language is not considered to be a positively recited limitation, but rather only requires an ability. Said rejections will be withdrawn upon an amendment positively reciting that the fibers are "obtained" or produced by the process of claim 1.

20. With respect to the rejection of claims 17 and 25 over the Joseph, Marini, and Beattey references, in further view of Nishiyama, Applicant merely repeats the traversal that the prior art does not teach the claimed wood pulp shoot age (Amendment B, page 21, 2nd paragraph). Since said traversal has been refuted, the rejection of claims 17 and 25 are also maintained.

Allowable Subject Matter

21. Claims 43 and 44 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. 112, second paragraph, set forth in this Office action.
22. Claims 35 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 35 and 36 contain allowable subject matter since the prior art does not teach or fairly suggest a cellulose fiber with the claimed parallel lamellae nanometer range which is produced by a process according to claim 1.

Conclusion

23. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

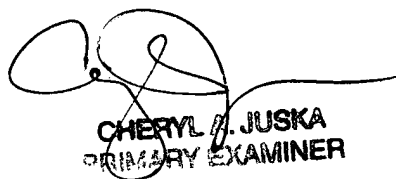
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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24. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Cheryl Juska whose telephone number is 703-305-4472. The Examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



CHERYL A. JUSKA
PRIMARY EXAMINER

cj
December 15, 2002